

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Mayer et al.
Application No.: 10/777,397
Confirmation No.: 5783
Filed: February 12, 2004
Examiner: Christopher Rodee
Art Unit: 1756
Last Office Action: August 29, 2006
Title: **TONER COMPOSITION**

CERTIFICATE OF MAILING

I hereby certify that this submission is being transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below.

11-28-06

(Date of deposit)

Lynda S. Kalemba


(Signature)

11-28-06

Date of Signature

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 CFR 1.132

Dear Sir or Madam:

The undersigned declare as follows:

1. I am a joint inventor in U.S. Patent Application 10/777,397, entitled "TONER COMPOSITION".
2. I have read and am familiar with the Office Actions issued on April 24, 2006, and August 29, 2006, in which the claims of the application were rejected.
3. I have read and am familiar with Japanese Patent Publication JP 06-180511.
4. I have read and am familiar with U.S. Patent No. 6,500,594 to Hamano et al.

5. I have read and am familiar with U.S. Patent No. 6,140,003 to Sacripante et al.

6. I have read and am familiar with U.S. Patent No. 6,017,671 to Sacripante et al.

7. I am aware that the claims of the application were rejected as obvious over the combination of Hamano 6,500,594 with JP 06-180511.

8. I am aware that the claims of the application were rejected as obvious over the combination of Sacripante 6,140,003 with JP 06-180511.

9. I am aware that the claims of the application were rejected as obvious over the combination of Sacripante 6,017,671 with JP 06-180511.

10. As one of ordinary skill in the art, I believe that it would not have been obvious to use the releasing agent disclosed by JP 06-180511 in any of the toners disclosed by Hamano 6,500,594; Sacripante 6,140,003; or Sacripante 6,017,671.

11. When using a wax as a release agent in a chemical toner, there are several parameters which must be met. The wax must be compatible with the sulfopolyester resin, have an adequate melting point to provide high gloss, and provide good charging performance. Not all waxes will meet these parameters.

12. With regards to the combination of Hamano 6,500,594 with JP 06-180511, I do not believe that it would be obvious to combine them because there is no indication that the release agent described in JP 06-180511 is compatible with sulfopolyester resin or has good charging performance.

13. With regards to the combination of Sacripante 6,140,003 with JP 06-180511, I do not believe that it would be obvious to combine them because there is no

indication that the release agent described in JP 06-180511 is compatible with sulfopolyester resin or has good charging performance. In addition, Sacripante discusses using waxes, such as polypropylenes and polyethylenes, having molecular weights Mw from about 1,000 to about 5,000. Stearyl stearamide, the release agent of the application, has only a molecular weight of about 540 grams per mole.

14. With regards to the combination of Sacripante 6,140,003 with JP 06-180511, I do not believe that it would be obvious to combine them because there is no indication that the release agent described in JP 06-180511 is compatible with sulfopolyester resin or has good charging performance. In addition, Sacripante discusses using waxes, such as polypropylenes and polyethylenes, having molecular weights Mw from about 1,000 to about 5,000. Stearyl stearamide, the release agent of the application, has only a molecular weight of about 540 grams per mole.

15. For these reasons, I do not believe that the toner described in the application is obvious over these combinations of references.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section

1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Fatima M. Mayer
Fatima M. Mayer

November 16, 2006
Date

Guerino G. Sacripante
Guerino G. Sacripante

November 08, 2006
Date

Edward G. Zwart
Edward G. Zwart

November 08, 2006
Date

Nicoleta Mihai
Nicoleta Mihai

November 13, 2006
Date

Enno E. Agur
Enno E. Agur

Nov. 8, 2006
Date